

Preliminary Amendment

Application 09/964,747
Attorney Docket: 042390.P12691**Remarks/Arguments**

Applicants would like to thank the Examiner for granting an interview to discuss the nature and purpose of the application and its relevance to electrical connectors. Applicants feel that the interview was productive and are grateful for the opportunity to advance the prosecution of this application.

Claims 1-28 are pending. Claims 1-28 are cancelled. Claims 29-41 are new.

In the final Office Action of November 17, 2003, Examiner rejected claims 1-9 and 23-28, and requested cancellation of claims 10-22, drawn to an invention nonelected with traverse. In the following remarks, Applicants restate their arguments regarding the rejections of claims 1-9 and 23-28, rejections Applicants believe were improper. Nonetheless, in the interest of advancing prosecution, applicants have cancelled claims 1-9 and 23-28, which were the subject of the final Office Action, and submitted new claims 29-41, which Applicants believe are drawn to patentable subject matter.

Applicants respectfully request that Examiner withdraw all rejections of the pending claims and allow all claims to issue.

S102 Rejection of the Claims

As mentioned above, Applicants restate their arguments regarding the rejections of claims 1-9 and 23-28, rejections Applicants believe were improper, at least in part because the cited patents appear to be drawn solely to electrical connections formed between two boards, or between a board and cabling.

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In the Office Action of November 17, 2003, claims 1-3 and 5 were rejected under 35 USC § 102(b) as being anticipated by Zink, et al. (U.S. 5,963,045). Applicants respectfully traverse this rejection.

To anticipate a claim, a reference must teach every element of the claim. MPEP § 2131. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference," Verdegaal Bros. v. Union Oil of California, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim," Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Further, "the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public," In re Brown, 141 USPQ 245, 249 (CCPA 1964). In particular, Brown repeats old law (1890) that states:

"the description must place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed. In order to accomplish this it must be so particular and definite that from it alone, without experiment or the exertion of his own inventive skill, any person versed in the art to which it appertains could construct and use it."

Id., at 249. In the present case, Zink's test unit 166 cannot "place the claimed embodiments in possession of the public as fully as if the art or instrument itself had been practically and publicly employed." Applicants respectfully assert that to construe a "test unit 166 10" as taught by Zink is repugnant to ordinary and plain usage of the term "board." Within the scope of the disclosure, which is Applicants' claimed scope, Zink fails to enable or anticipate the rejected claims.

Zink does not teach the limitation in claim 1 of an "extension board." The structure in Zink is a test fixture 166 (FIG. 11) that does not couple to the circuit board 145. Rather, it is brought into alignment so that test probes 154-160 will engage conductive pads 146-152. Zink's test fixture 166 is not a board. Consequently, claims 1-5 are not anticipated by Zink. That Zink's test fixture 166

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may have certain dimensions of "thin and flat" (Office Action at page 2), is immaterial to the scope of what is claimed. Withdrawal of the rejections is respectfully requested.

Claims 1-9 and 23-28 were also rejected under 35 USC § 102(b) as being anticipated by Korsunsky, et al. (U.S. 5,383,095). Applicants respectfully traverse this rejection and request that the Examiner consider the following.

Korsunsky does not teach the limitations in independent claims 1, 6, 23, and 26 of an "extension board." The structure in Korsunsky is an electrical connector 10 that cannot be construed to be a board. The Office Action states this assertion is not supported (Office Action at page 3). Applicants respectfully insist that a "board" is not an appropriate appellation for the "edge-mounted electrical connector 10" taught by Korsunsky. Were it appropriate, Korsunsky would call it a "board 10" similar to his appellation for his "circuit board 12." The structure 10 of Korsunsky is a multi-dimensional, multi-level structure that is not a "board." In the present case, Korsunsky's edge-mounted electrical connector 10 cannot "place the claimed embodiments in possession of the public as fully as if the art or instrument itself had been practically and publicly employed" (Brown, *supra*). Applicant respectfully asserts that to construe an "edge-mounted electrical connector 10" as taught by Korsunsky is repugnant to ordinary and plain usage of the term "board." Within the scope of the disclosure, which is Applicant's claimed scope, Korsunsky fails to enable or anticipate the rejected claims.

Further, as to independent claims 23 and 26, Korsunsky fails to teach any functionality "for maintaining said top surface of said extension board relatively coplanar with said top surface of said printed circuit board" (claim 23, e.g.). Consequently, claims 1-9 and 23-28 are not anticipated by Korsunsky.

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The Office Action insists that a structure difference must be present. Applicants have demonstrated Korsunsky and what is claimed represent a structural difference, since Korsunsky does not and cannot teach top and bottom surfaces of a board that includes a key. Withdrawal of the rejections is respectfully requested.

New Claims

In the interest of advancing prosecution, applicants have submitted new claims 29-41, which Applicants believe are drawn to patentable subject matter. Applicants believe that the new claims further clarify and distinguish the claimed invention over the cited art, and respectfully request examination and allowance of these new claims. Support for the new claims is found in the specification, the drawings, and in the claims as originally filed. Applicants submit that the new claims do not add new matter.

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In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance, and indication of allowance by the Examiner is respectfully requested. If the Examiner has any questions, Examiner is invited to contact the undersigned at (703) 633-0927. If any fee insufficiency or overpayment is found, please charge the insufficiency or credit the overpayment to Deposit Account 02-2666.

Respectfully submitted,

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